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| 10/040,843      | 01/07/2002  | James Samsoondar     | 31773-CIP1          | 3741             |

23589 7590 07/14/2004

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| EXAMINER |
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MARSCHER, ARDIN H

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| ART UNIT | PAPER NUMBER |
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1631

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SYM

**Office Action Summary****Application No.**

10/040,843

**Applicant(s)**

SAMSOONDAR, JAMES

**Examiner**

Ardin Marschel

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-18, 20 and 22 is/are pending in the application.  
~~1-11, 19, 21, & 23-28 have been canceled. (is/are withdrawn from consideration)~~
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-18, 20, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 12/22/03.
- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Applicant's election of Group II (claims 12-18, 20, and 22) in the reply, filed on 4/19/04, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

**PRIORITY DOCUMENTS**

If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. It is noted that this appears as the first sentence of the specification following the title. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35

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U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

### **VAGUENESS AND INDEFINITENESS**

Claims 12-18, 20, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 12, the first dispensing tip is described as being sealable as well as being sealed. The metes and bounds of what sealability or sealed practice is meant are vague and indefinite and not set forth. For example, is sealing limited to liquid sample containment or is the sealing directed to keeping the sample sterile, for example? Is the sealing meant to be a barrier practice such as a rubber cap that is penetrated via the second dispensing tip during its usage in the claimed method? Is the sealing practice air sealing or liquid sealing? No definition as to what is being sealed against is set forth thus leaving the claims vague and indefinite as to the metes and bounds of sealing practice. Claims which depend directly or indirectly from claim 12 also contain this unclarity due to their dependence. Clarification is requested via clearer claim wording.

#### **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12, 13, and 16 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by Juranas (P/N 6,368,872).

As a preliminary comment the instant application is not granted priority to the earliest priority document U.S. Provisional application Serial Number 60/078,780 due to

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consideration thereof failing to find written support therein for the presently pending instantly claimed invention, thus resulting in Juranas being prior art.

In Figures 1, 2A, and 2B; Juranas depicts a pipetting system with various parts which are directed to chemical processing or analyzing as summarized in column 4, lines 55-63 (as required for instant claim 16). This system including methods of sample manipulation is disclosed in column 2, line 64, through column 4, line 45. Figures 2A and 2B are disclosed in Juranas as prior art thereto but still is disclosure which anticipates the instantly pending claims therein. In Figures 2A and 2B two tips are shown which perform aspiration of samples numbered items 30 and 22. Item 30, having first and second ends, corresponds to the first dispensing tip of the instant claims. Item 22 corresponds to the second dispensing tip of the instant claims. In the bridging paragraph between columns 3 and 4 of the reference the tip 30 is sealable onto the sheath item 18 and is also sealed onto said sheath as required in the instant claims (by mechanical movement together which is reasonably compression sealing as required in instant claim 13). Item 22 (second dispensing tip) also seals with first dispensing tip 30. Further details are set forth in column 4, lines 9-45, of the operation of said tips for sample or reagent uptake and dispensing. It is noted that steps i) and ii) of instant claim 12 are not required to be performed in any specific order. Therefore the sealing of the first dispensing tip either with sheath 18 or the second tip 22 before sample aspiration reads on embodiments of the instant claims regarding steps i) and ii). Step iii) of instant claim 12 is disclosed in the reference in column 3, line 52, through column 4, line 45, wherein second tip item 22 seals with first dispensing tip 30 and

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aspirates sample within the first dispensing tip via air pressure control therefore anticipating said step iii). It is noted that instant claim 12 includes embodiments with either of steps iii) or iv) being performed without requiring both. Therefore the above instant claims are anticipated.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

July 9, 2004

*Ardin D. Marschel*  
ARDIN D. MARSCHEL  
7/9/04